

ATTORNEY DOCKET No. 13053STUS01U (NORT10-00100)
U.S. SERIAL NO. 09/739,708
PATENT

REMARKS

Claims 1-31 are pending in the application.

Claims 1-31 have been rejected.

Claims 1, 3, 16, 18, 27 and 30 have been amended

Claims 2 and 17 have been canceled, without prejudice.

Reconsideration of the Claims is respectfully requested.

I. REJECTION UNDER 35 U.S.C. § 102

Claims 1-31 were rejected under 35 U.S.C. § 102(e) as being anticipated by Brilla (US 6,389,276). The rejection is respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Brilla recites that when a new voicemail message is received in a landline-based voicemail system, a remote notification is sent to a wireless mobile telephone to indicate that the voicemail message is present in the voicemail system. The message platform outputs an email message (having as its content the destination number of the mobile telephone) to an address of a server in the wireless network. The server then generates a command which is sent

ATTORNEY DOCKET No. 13053STUS01U (NORT10-00100)
U.S. SERIAL No. 09/739,708
PATENT

to the mobile telephone that causes the mobile telephone to activate a message waiting indicator - indicating that a new voicemail message is waiting at the landline premises. Brilla, Abstract; Col. 6, line 54 thru Col. 11, line 44. As such, Brilla teaches that a "mobile subscriber can be alerted via his or her mobile telephone 122 of a message stored from an incoming call to his or her landline telephone 104" (Col. 11, lines 42-44), and "to enable a user of a digital telephone 122 to receive wireless commands to activate a message waiting indicator on the digital telephone 122 indicating storage of a voicemail message at the voicemail system 110." (Col. 7, lines 53-57).

Brilla does not disclose that after dropping a synchronous call attempt to a called party, a message composed by the calling party is received, recorded, and sent to a determined communication address (associated with the called party). Brilla merely describes a conventional voicemail system - where a call to a called party is connected and diverted to a voicemail system for recordal of a voice message. In contrast, Applicant's method includes dropping an unsuccessful (i.e., detecting a busy signal or predetermined number of rings, detecting transfer to a messaging system, or detecting an indication from the calling party that the call attempt is unsuccessful, see Applicant's Specification, page 2, lines 26-30) call attempt to the called party, and after dropping the unsuccessful call attempt (no actual connection to called party device, or disconnection of a connection to the called party's device or messaging system), then receiving a message from the called party, recording the received message, and sending the recorded message to a determined communication address associated with the called party. Applicant believes that the previously presented claims properly distinguished

ATTORNEY DOCKET No. 13053STUS01U (NORT10-00100)
U.S. SERIAL No. 09/739,708
PATENT

over the Brilla reference.¹ However, to further prosecution, Applicant has amended independent Claim 1 to further recite determining that said synchronous call attempt to said called party is unsuccessful, and after determining that said synchronous call attempt is unsuccessful, dropping said synchronous call attempt to said called party. (similar amendments have been made to the other independent claims).

From these amendments, it is clear that only after the synchronous call attempt is determined to be unsuccessful (as described in the Specification, page 2, lines 26-30) then the call attempt is dropped, and after the call attempt is dropped (no further connection to the called party device (including the called party's messaging system)), a message is received, recorded and sent to a determined communication address associated with the called party. Thus, Applicant's claims patentably distinguish over Brilla. There is no disclosure or description that would allow the called party in Brilla to record a message in that called party's messaging system when the call attempt to the called party is dropped (no connection). As noted earlier, Brilla receives and records a message from a calling party during the connection (diverted from the called party to the called party's messaging system) to the called party's messaging system. In contrast, Applicant's receives (from the calling party), records and sends the recorded

¹ In addition, Applicant respectfully disagrees that the "claims 1-31 read on a calling party using a wireless phone to call a called party's wireless phone." See, Office Action, page 4. The claims also recite that a message is received (from the calling party), recorded, and sent to a communication address associated with the called party, all after the unsuccessful call attempt is dropped. Conventional systems do not appear to drop the call to the called party, but merely divert the call to the called party's messaging system (which then receives and records a message).

ATTORNEY DOCKET NO. 130S3STUS01U (NORT10-00100)
U.S. SERIAL. NO. 09/739,708
PATENT

message all after the call is dropped (thus, no connection exists to the called party or the called party's messaging system). Therefore, Brilla fails to disclose each and every element/feature of the Applicant's invention, as claimed.

The addition of the element directed to "determining that said synchronous call attempt to said called party is unsuccessful" was previously recited in dependent Claims 2 and 17 (now canceled), while the addition of the element that the dropping of the synchronous call attempt to the called party is done after the call attempt is determined to be unsuccessful is merely a clarifying amendment. Thus, no new issues are raised by the amendment.

Accordingly, the Applicant respectfully requests the Examiner withdraw the § 102(e) rejection of Claims 1, 3-16, 18-31.

II. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

ATTORNEY DOCKET NO. 13053STUS01U (NORT10-00100)
U.S. SERIAL NO. 09/739,708
PATENT

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at rmccutcheon@davismunck.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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Page 15 of 15